

JUL 16 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Travis J. Parry	Examiner:	Peter K Huntsinger
Serial No.:	10/092,050	Group Art Unit:	2625
Filed:	March 5, 2002	Docket No.:	10008068-1
Title:	PRINTER OPTION SUGGESTION METHOD AND PROGRAM		

CERTIFICATE OF TRANSMISSION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

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Patent and Trademark Office, Fax No.: (571) 273-8300 on the date shown below:

1. Transmittal Letter for Appeal Brief (1 pg.); and
2. Appeal Brief under 37 C.F.R. §41.37 (21 pgs.).

Respectfully submitted,

Travis J. Parry,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 573-2006
Facsimile: (612) 573-2005

Date: July 16, 2007
SAL:hsf

By: 

Scott A. Lund
Reg. No. 41,166

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HEWLETT-PACKARD COMPANY
 Intellectual Property Administration
 P.O. Box 272400
 Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10008068-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Travis J. Parry

Confirmation No.: 1359

Application No.: 10/092,050

Examiner: Peter K. Huntsinger

Filing Date: March 5, 2002

Group Art Unit: 2625

Title: PRINTER OPTION SUGGESTION METHOD AND PROGRAM

Mail Stop Appeal Brief-Patents
 Commissioner For Patents
 PO Box 1450
 Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on May 16, 2007.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
 \$120

☐ 2nd Month
 \$450

☐ 3rd Month
 \$1020

☐ 4th Month
 \$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500 . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.18 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Date of facsimile: July 16, 2007

Typed Name: Scott A. Lund

Signature: 

Respectfully submitted,

Travis J. Parry

By: 

Scott A. Lund

Attorney/Agent for Applicant(s)

Reg No.: 41,168

Date: July 16, 2007

Telephone: 612.573.2006

Rev 10/05 (Ap/Brief)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:	Travis J. Parry	Examiner:	Peter K Huntsinger
Serial No.:	10/092,050	Group Art Unit:	2625
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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

This Appeal Brief is submitted in support of the Notice of Appeal filed May 16, 2007, appealing the rejection of claims 1-20 of the above-identified application as set forth in the Final Office Action mailed February 20, 2007.

The U.S. Patent and Trademark Office is hereby authorized to charge **Deposit Account No. 08-2025** in the amount of **\$500.00** for filing a Brief in Support of an Appeal as set forth under 37 C.F.R. § 41.20(b)(2). At any time during the pendency of this application, please charge any required fees or credit any overpayment to Deposit Account No. 08-2025.

Appellant respectfully requests reconsideration and reversal of the Examiner's rejection of pending claims 1-20.

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**Appeal Brief to the Board of Patent Appeals and Interferences
of the United States Patent and Trademark Office**

Appellant: Travis J. Parry

Serial No.: 10/092,050

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REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

RELATED APPEALS AND INTERFERENCES

Appellant submits that there are no related appeals or interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-20 are pending in the application (see Claims Appendix), and are the subject of the present Appeal. Claims 21 and 22 were previously cancelled without prejudice.

Claims 1-9, 11, 12, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igval Patent No. 6,045,206 in view of Nguyen et al. US Patent No. 6,825,941.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Igval US Patent No. 6,045,206 and Nguyen et al. US Patent No. 6,825,941, and further in view of known prior art.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Igval US Patent No. 6,045,206 and Nguyen et al. US Patent No. 6,825,941, and further in view of Hopkins US Patent No. 5,390,004.

Claims 16, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igval US Patent No. 6,045,206 in view of Overall et al. US Patent No. 5,797,061, and further in view of Nguyen et al. US Patent No. 6,825,941.

Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igval US Patent No. 6,045,206, Overall et al. US Patent No. 5,797,061, and Nguyen et al. US Patent No. 6,825,941, and further in view of known prior art.

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STATUS OF AMENDMENTS

No amendments have been proposed or entered subsequent to the Final Office Action mailed February 20, 2007. The claims listed in the Claims Appendix, therefore, reflect the claims as of February 20, 2007.

Appellant's reply filed April 20, 2007 overcame the rejection of claims 1-20 under 35 U.S.C. 112, first paragraph (see Advisory Action mailed 05/08/2007, item 5).

SUMMARY OF THE CLAIMED SUBJECT MATTER

One aspect of the present invention, as claimed in independent claim 1, provides a method for improving use of printing devices in a network computer system. The method includes determining usage characteristics (200) of at least one printing device (110); determining all options available (210) for said at least one printing device, said available options including paper handling, consumable, servicing, print processing, configuration, software, and hardware options for said at least one printing device; determining all installed options (220) currently existing on said at least one printing device, said installed options including paper handling, consumable, servicing, print processing, configuration, software, and hardware options of said at least one printing device; and determining a set of optimal options (230;240) for said at least one printing device based on said usage characteristics, said available options and said installed options (see, e.g., Specification, para. [0022] - [0025], [0028], [0035]; FIG. 2).

One aspect of the present invention, as claimed in independent claim 16, provides a method for suggesting printing device options in a network computer system. The method includes operating a device management program (162) on a computer connected to a network communication; determining usage characteristics (200) including an amount and type of use of at least one printing device (110) with said device management program; operating a computer program (170) on said computer; using said computer program to determine all options available (210) for said at least one printing device, said available options including paper handling, consumable, servicing, print processing, configuration, software, and hardware options for said at least one printing device; using said computer program to determine all installed options (220) present on said at least one printing device, said installed options including paper handling, consumable, servicing, print processing,

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configuration, software, and hardware options of said at least one printing device; and using said computer program to determine an optimal set of options (230;240) for said at least one printing device based on said usage characteristics, said available options and said installed options (see, e.g., Specification, para. [0022] - [0035]; FIGS. 1 and 2).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Appellant seeks review of the rejection of claims 1-9, 11, 12, 14, and 15 under 35 U.S.C. 103(a) as being unpatentable over Igval Patent No. 6,045,206 in view of Nguyen et al. US Patent No. 6,825,941.

Appellant seeks review of the rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over Igval US Patent No. 6,045,206 and Nguyen et al. US Patent No. 6,825,941, and further in view of known prior art.

Appellant seeks review of the rejection of claim 13 under 35 U.S.C. 103(a) as being unpatentable over Igval US Patent No. 6,045,206 and Nguyen et al. US Patent No. 6,825,941, and further in view of Hopkins US Patent No. 5,390,004.

Appellant seeks review of the rejection of claims 16, 18, and 20 under 35 U.S.C. 103(a) as being unpatentable over Igval US Patent No. 6,045,206 in view of Overall et al. US Patent No. 5,797,061, and further in view of Nguyen et al. US Patent No. 6,825,941.

Appellant seeks review of the rejection of claims 17 and 19 under 35 U.S.C. 103(a) as being unpatentable over Igval US Patent No. 6,045,206, Overall et al. US Patent No. 5,797,061, and Nguyen et al. US Patent No. 6,825,941, and further in view of known prior art.

ARGUMENT

I. Rejections Under 35 U.S.C. §103

A. Applicable Law

Under 35 U.S.C. §103, the Examiner has the burden to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Three criteria must be satisfied to establish a *prima facie* case of obviousness. First, the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would teach, suggest, or motivate one to

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modify a reference or to combine the teachings of multiple references. *Id.* Second, the prior art can be modified or combined only so long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Third, the prior art reference or combined prior art references must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). These three criteria are also set forth in M.P.E.P § 706.02(j). In performing the obviousness inquiry under 35 U.S.C. § 103, the Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990).

B. Rejection of claims 1-9, 11, 12, 14, and 15 under 35 U.S.C. § 103(a)

Because the rejection of claims 1-9, 11, 12, 14, and 15 under 35 U.S.C. 103(a) as being unpatentable over Igval Patent No. 6,045,206 in view of Nguyen et al. US Patent No. 6,825,941 fails to establish a *prima facie* case of obviousness, the rejection of claims 1-9, 11, 12, 14, and 15 is not correct and should be withdrawn.

Independent claim 1 includes "determining usage characteristics of at least one printing device;" "determining all options available for said at least one printing device, said available options including paper handling, consumable, servicing, print processing, configuration, software, and hardware options for said at least one printing device;" "determining all installed options currently existing on said at least one printing device, said installed options including paper handling, consumable, servicing, print processing, configuration, software, and hardware options of said at least one printing device;" and "determining a set of optimal options for said at least one printing device based on said usage characteristics, said available options and said installed options."

The Examiner contends that Igval discloses a method for improving use of printing devices in a network computer system, comprising: determining usage characteristics of at least one printing device; determining all options available for said at least one printing device, said available options including servicing options for said at least one printing device; determining all installed options currently existing on said at least one printing device, said installed options including servicing options of said at least one printing device; and determining a set of optimal options for said at least one printing device based on said usage characteristics, said available options and said installed options (Final Office Action mailed 02/20/2007, page 3).

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The Examiner recognizes that Igval does not disclose options including paper handling, consumable, print processing, configuration, software, and hardware options (Final Office Action mailed 02/20/2007, page 3). As such, the Examiner contends that Nguyen et al. disclose determining all options available for said at least one printing device, said available options including paper handling, consumable, print processing, configuration, software, and hardware options for said at least one printing device; and determining all installed options currently existing on said at least one printing device, said installed options including paper handling, consumable, print processing, configuration, software, and hardware options of said at least one printing device (Final Office Action mailed 02/20/2007, pages 3-4). Thus, the Examiner suggests that it would have been obvious to combine Nguyen et al. with Igval to obtain the invention as specified in claim 1 (Final Office Action mailed 02/20/2007, page 4).

The Igval patent discloses a method of operating an ink jet printer including using a maintenance algorithm to control timing of a maintenance action, keeping a historical log of an operating characteristic of the ink jet printer over a period of time, and changing the maintenance algorithm for subsequent use by the ink jet printer based upon the historical log (see Abstract). More specifically, the Igval patent is directed to an ink jet printer having a variable maintenance algorithm that adapts to the actual usage patterns of the ink jet printer so as to optimize the consumption of ink (col. 1, lines 5-10). For example, the Igval patent provides that a maintenance algorithm #1 is the default algorithm while maintenance algorithms #2-4 are alternative maintenance algorithms that may be adopted for use if the usage pattern of the postage printing system 100 permits (col. 6, lines 20-24). The Igval patent, therefore, is directed to changing a maintenance algorithm based on usage only.

The Igval patent, however, does not determine all options available for a printing device, does not determine all installed options currently existing on a printing device, and does not determine a set of optimal options for a printing device based on the usage characteristics, the available options and the installed options, wherein the available options for the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options for the printing device, and the installed options currently existing on the printing device include paper handling, consumable,

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servicing, print processing, configuration, software, and hardware options of the printing device.

The Nguyen patent discloses a modular Universal Printer Driver which operates in conjunction with OEM developed minidrivers which utilize a text based Generic Printer Description (GPD) format such that the universal driver allows the GPD text based minidrivers to add and define new features introduced by the printer OEM, and the universal driver also allows the GPD minidriver to modify, add, or replace the standard user interface provided by the universal driver (Abstract). More specifically, the Nguyen patent discloses that the Generic Printer Description (GPD) format provides support for generic features, provides support for custom help, provides support for installable options, and provides support for various types of constraints (col. 3, line 60 - col. 4, line 10). In this regard, the Nguyen patent discloses that "[t]he driver UI asks the user which options are actually installed and allow[s] users to select only those that are installed" (emphasis added) (col. 4, lines 2-4). The Nguyen patent, therefore, simply provides a universal printer driver and a printer description file format (i.e., GPD) for outputting data to an output device, such as a printer.

The Nguyen patent, however, does not determine all options available for a printing device, does not determine all installed options currently existing on a printing device, and does not determine a set of optimal options for a printing device based on the usage characteristics, the available options and the installed options, wherein the available options for the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options for the printing device, and the installed options currently existing on the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options of the printing device.

Accordingly, Appellant submits that modifying the Igval patent in view of the Nguyen patent does not overcome the shortcomings of the Igval patent. More specifically, Appellant submits that the combination of the Igval and Nguyen patents does not determine all options available for a printing device, does not determine all installed options currently existing on a printing device, and does not determine a set of optimal options for a printing device based on the usage characteristics, the available options and the installed options,

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wherein the available options for the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options for the printing device, and the installed options currently existing on the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options of the printing device, as claimed in independent claim 1. Appellant notes that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

In view of the above, Appellant submits that the Examiner has not established a *prima facie* case of obviousness of independent claim 1, and submits that independent claim 1 is patentably distinct from the Igval and Nguyen references. Furthermore, as dependent claims 2-9, 11, 12, 14, and 15 further define patentably distinct claim 1, Appellant submits that these dependent claims are also patentably distinct from the Igval and Nguyen references. Appellant, therefore, respectfully submits that the rejection of claims 1-9, 11, 12, 14, and 15 under 35 U.S.C. §103(a) is not correct and should be withdrawn, and submits that claims 1-9, 11, 12, 14, and 15 should be allowed.

C. Rejection of claim 10 under 35 U.S.C. §103(a)

Because the rejection of claim 10 under 35 U.S.C. 103(a) as being unpatentable over Igval US Patent No. 6,045,206 and Nguyen et al. US Patent No. 6,825,941, and further in view of known prior art fails to establish a *prima facie* case of obviousness, the rejection of claim 10 is not correct and should be withdrawn.

Regarding the rejection of claim 10 under 35 U.S.C. 103(a), Appellant notes that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 10 depends from independent claim 1 and, as such, includes all of the limitations of independent claim 1. As outlined above, Appellant submits that the combination of the Igval and Nguyen patents does not determine all options available for a printing device, does not determine all installed options currently existing on a printing

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device, and does not determine a set of optimal options for a printing device based on the usage characteristics, the available options and the installed options, wherein the available options for the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options for the printing device, and the installed options currently existing on the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options of the printing device, as claimed in independent claim 1.

In view of the above, Appellant submits that the Examiner has not established a *prima facie* case of obviousness of independent claim 1 and, therefore, has not established a *prima facie* case of obviousness of dependent claim 10. Appellant, therefore, respectfully submits that the rejection of claim 10 under 35 U.S.C. §103(a) is not correct and should be withdrawn, and submits that claim 10 should be allowed.

D. Rejection of claim 13 under 35 U.S.C. §103(a)

Because the rejection of claim 13 under 35 U.S.C. 103(a) as being unpatentable over Igval US Patent No. 6,045,206 and Nguyen et al. US Patent No. 6,825,941, and further in view of Hopkins US Patent No. 5,390,004 fails to establish a *prima facie* case of obviousness, the rejection of claim 13 is not correct and should be withdrawn.

Regarding the rejection of claim 13 under 35 U.S.C. 103(a), Appellant notes that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 13 depends from independent claim 1 and, as such, includes all of the limitations of independent claim 1. As outlined above, Appellant submits that the combination of the Igval and Nguyen patents does not determine all options available for a printing device, does not determine all installed options currently existing on a printing device, and does not determine a set of optimal options for a printing device based on the usage characteristics, the available options and the installed options, wherein the available options for the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options for the printing device, and the

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installed options currently existing on the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options of the printing device, as claimed in independent claim 1.

In view of the above, Appellant submits that the Examiner has not established a *prima facie* case of obviousness of independent claim 1 and, therefore, has not established a *prima facie* case of obviousness of dependent claim 13. Appellant, therefore, respectfully submits that the rejection of claim 13 under 35 U.S.C. §103(a) is not correct and should be withdrawn, and submits that claim 13 should be allowed.

E. Rejection of claims 16, 18, and 20 under 35 U.S.C. §103(a)

Because the rejection of claims 16, 18, and 20 under 35 U.S.C. 103(a) as being unpatentable over Igval US Patent No. 6,045,206 in view of Overall et al. US Patent No. 5,797,061, and further in view of Nguyen et al. US Patent No. 6,825,941 fails to establish a *prima facie* case of obviousness, the rejection of claims 16, 18, and 20 is not correct and should be withdrawn.

Independent claim 16 includes "determining usage characteristics including an amount and type of use of at least one printing device with said device management program;" "using said computer program to determine all options available for said at least one printing device, said available options including paper handling, consumable, servicing, print processing, configuration, software, and hardware options for said at least one printing device;" "using said computer program to determine all installed options present on said at least one printing device, said installed options including paper handling, consumable, servicing, print processing, configuration, software, and hardware options of said at least one printing device;" and "using said computer program to determine an optimal set of options for said at least one printing device based on said usage characteristics, said available options and said installed options."

The Examiner contends that Igval discloses a method for suggesting printing device options in a network computer system, comprising: determining the usage characteristics of at least one printing device; operating a computer program on a computer; using said computer program to determine all options available for said at least one printing device; using said computer program to determine all installed options currently existing on said at least one printing device; and using said computer program to determine a set of optimal

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options for said at least one printing device based on said usage characteristics, said available options and said installed options (Final Office Action mailed 02/20/2007, pages 7-8).

The Examiner recognizes that Igval does not disclose determining the usage characteristics and suggesting options with a program run on a computer (Final Office Action mailed 02/20/2007, page 8). As such, the Examiner contends that Overall et al. disclose determining the usage characteristics of a printing device with a device management program (Final Office Action mailed 02/20/2007, page 8). The Examiner also recognizes that Igval does not disclose options including paper handling, consumable, print processing, configuration, software, and hardware options (Final Office Action mailed 02/20/2007, page 8). As such, the Examiner contends that Nguyen et al. disclose using a computer program to determine all options available for said at least one printing device, said available options including paper handling, consumable, print processing, configuration, software, and hardware options for said at least one printing device; and using said computer program to determine all installed options currently existing on said at least one printing device, said installed options including paper handling, consumable, print processing, configuration, software, and hardware options of said at least one printing device (Final Office Action mailed 02/20/2007, pages 8-9). Thus, the Examiner suggests that it would have been obvious to combine Overall et al. and Nguyen et al. with Igval to obtain the invention as specified in claim 16 (Final Office Action mailed 02/20/2007, page 9).

The Overall patent discloses a printer that predicts how many pages can be printed before the toner or ink cartridge becomes empty, and also predicts how much time remains before the toner or ink cartridge becomes empty (see Abstract). The Overall patent, however, does not determine all options available for a printing device, does not determine all installed options present on a printing device, and does not determine a set of optimal options for a printing device based on the usage characteristics, the available options and the installed options, wherein the available options for the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options for the printing device, and the installed options present on the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options of the printing device.

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As outlined above, the Nguyen patent provides a universal printer driver and a printer description file format (i.e., GPD) for outputting data to an output device, such as a printer, wherein "[t]he driver UI asks the user which options are actually installed and allow[s] users to select only those that are installed" (emphasis added) (col. 4, lines 2-4). The Nguyen patent, however, does not determine all options available for a printing device, does not determine all installed options present on a printing device, and does not determine a set of optimal options for a printing device based on the usage characteristics, the available options and the installed options, wherein the available options for the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options for the printing device, and the installed options present on the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options of the printing device.

Accordingly, Appellant submits that modifying the Igval patent in view of the Overall and Nguyen patents does not overcome the shortcomings of the Igval patent. More specifically, Appellant submits that the combination of the Igval, Overall, and Nguyen patents does not determine all options available for a printing device, does not determine all installed options present on a printing device, and does not determine a set of optimal options for a printing device based on the usage characteristics, the available options and the installed options, wherein the available options for the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options for the printing device, and the installed options present on the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options of the printing device, as claimed in independent claim 16. Appellant notes that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

In view of the above, Appellant submits that the Examiner has not established a *prima facie* case of obviousness of independent claim 16, and submits that independent claim 16 is patentably distinct from the Igval, Overall, and Nguyen references. Furthermore, as dependent claims 18 and 20 further define patentably distinct claim 16, Appellant submits that these dependent claims are also patentably distinct from the Igval, Overall, and Nguyen

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references. Appellant, therefore, respectfully submits that the rejection of claims 16, 18, and 20 under 35 U.S.C. §103(a) is not correct and should be withdrawn, and submits that claims 16, 18, and 20 should be allowed.

F. Rejection of claims 17 and 19 under 35 U.S.C. §103(a)

Because the rejection of claims 17 and 19 under 35 U.S.C. 103(a) as being unpatentable over Igval US Patent No. 6,045,206, Overall et al. US Patent No. 5,797,061, and Nguyen et al. US Patent No. 6,825,941, and further in view of known prior art fails to establish a *prima facie* case of obviousness, the rejection of claims 17 and 19 is not correct and should be withdrawn.

Regarding the rejection of claims 17 and 19 under 35 U.S.C. 103(a), Appellant notes that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claims 17 and 19 depend from independent claim 16 and, as such, include all of the limitations of independent claim 16. As outlined above, Appellant submits that the combination of the Igval, Overall, and Nguyen patents does not determine all options available for a printing device, does not determine all installed options present on a printing device, and does not determine a set of optimal options for a printing device based on the usage characteristics, the available options and the installed options, wherein the available options for the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options for the printing device, and the installed options present on the printing device include paper handling, consumable, servicing, print processing, configuration, software, and hardware options of the printing device, as claimed in independent claim 16.

In view of the above, Appellant submits that the Examiner has not established a *prima facie* case of obviousness of independent claim 16 and, therefore, has not established a *prima facie* case of obviousness of dependent claims 17 and 19. Appellant, therefore, respectfully submits that the rejection of claims 17 and 19 under 35 U.S.C. §103(a) is not correct and should be withdrawn, and submits that claims 17 and 19 should be allowed.

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CONCLUSION

For the above reasons, Appellant respectfully submits that the art of record neither anticipates nor renders obvious the claimed invention. Thus, the claimed invention does patentably distinguish over the art of record. Appellant, therefore, respectfully submits that the above rejections are not correct and should be withdrawn, and respectfully requests that the Examiner be reversed and that all pending claims be allowed.

Any inquiry regarding this Appeal Brief should be directed to either Nathan R. Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

IP Administration
Legal Department, M/S 35
HEWLETT-PACKARD COMPANY
P.O. Box 272400
Fort Collins, Colorado 80527-2400

Respectfully submitted,

Travis J. Parry,

By,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 573-2006
Facsimile: (612) 573-2005

Date: July 16, 2007
SAL:hsf


Scott A. Lund
Reg. No. 41,166

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (571) 273-8300 on this 16TH day of July, 2007.

By 
Name: Scott A. Lund

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CLAIMS APPENDIX

1. (Previously Presented) A method for improving use of printing devices in a network computer system, comprising:
 - determining usage characteristics of at least one printing device;
 - determining all options available for said at least one printing device, said available options including paper handling, consumable, servicing, print processing, configuration, software, and hardware options for said at least one printing device;
 - determining all installed options currently existing on said at least one printing device, said installed options including paper handling, consumable, servicing, print processing, configuration, software, and hardware options of said at least one printing device; and
 - determining a set of optimal options for said at least one printing device based on said usage characteristics, said available options and said installed options.
2. (Original) The method of claim 1, further comprising suggesting at least one change to said at least one printing device for optimizing the use of said at least one printing device with said network computer system.
3. (Previously Presented) The method of claim 2, wherein said suggesting at least one change to said at least one printing device for optimizing the use of said at least one printing device with said network computer system comprises suggesting an option selected from the group consisting of using a toner miser function, turning on a job retention memory, and suggesting other printing device configurations.
4. (Previously Presented) The method of claim 1, wherein said determining the usage characteristics of at least one printing device comprises determining the usage characteristics of all printing devices operating on said network computer system.
5. (Previously Presented) The method of claim 1, wherein said determining the usage characteristics of at least one printing device comprises monitoring said at least one printing device to determine said usage characteristics.

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6. (Previously Presented) The method of claim 1, wherein said determining the usage characteristics of at least one printing device comprises retrieving said usage characteristics from a database.
7. (Previously Presented) The method of claim 1, wherein said determining the usage characteristics of at least one printing device comprises determining at least one usage characteristic selected from the group consisting of paper use rate, toner use rate, power use rate, time of print job request, consumable use per job rate, and print job request rate.
8. (Previously Presented) The method of claim 1, wherein said determining all options available for said at least one printing device comprises retrieving said available options from a database.
9. (Previously Presented) The method of claim 1, wherein said determining all options available for said at least one printing device comprises querying said at least one printing device to retrieve said available options.
10. (Previously Presented) The method of claim 1, wherein said determining all options available for said at least one printing device comprises querying a web-site for said available options.
11. (Previously Presented) The method of claim 1, wherein said determining all installed options currently existing on said at least one printing device comprises retrieving said installed options from a database.
12. (Previously Presented) The method of claim 1, wherein said determining all installed options currently existing on said at least one printing device comprises querying said at least one printing device to retrieve said installed options.
13. (Previously Presented) The method of claim 1, wherein said determining a set of optimal options for said at least one printing device based on said usage characteristics, said

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available options and said installed options comprises using fuzzy logic to determine said set of optimal options for said at least one printing device.

14. (Previously Presented) The method of claim 1, further comprising suggesting at least one service to incorporate with said at least one printing device for providing enhanced usage of said at least one printing device.

15. (Previously Presented) The method of claim 14, wherein said suggesting at least one service to incorporate with said at least one printing device comprises suggesting at least one service selected from the group consisting of a maintenance service, a charge per page service, and a printing device monitoring service.

16. (Previously Presented) A method for suggesting printing device options in a network computer system, comprising:

- operating a device management program on a computer connected to a network communication;

- determining usage characteristics including an amount and type of use of at least one printing device with said device management program;

- operating a computer program on said computer;

- using said computer program to determine all options available for said at least one printing device, said available options including paper handling, consumable, servicing, print processing, configuration, software, and hardware options for said at least one printing device;

- using said computer program to determine all installed options present on said at least one printing device, said installed options including paper handling, consumable, servicing, print processing, configuration, software, and hardware options of said at least one printing device; and

- using said computer program to determine an optimal set of options for said at least one printing device based on said usage characteristics, said available options and said installed options.

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17. (Previously Presented) The method of claim 16, wherein said using said computer program to determine all options available for said at least one printing device comprises:
- connecting to the Internet; and
 - querying a web-site for information about said at least one printing device.
18. (Previously Presented) The method of claim 16, wherein said computer program is configured to communicate with said device management program.
19. (Previously Presented) The method of claim 16, wherein said computer program is a component of said device management program.
20. (Previously Presented) The method of claim 16, wherein using said computer program to determine an optimal set of options for said at least one printing device comprises using said computer program to compare said installed options with said available options.
21. (Cancelled)
22. (Cancelled)

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EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.